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No. 293

In the Supreme Court of the United States

October Term 1962

CARL W. MELLIS ENGINEERING AND MANUFACTURING COMPANY, INC., *Petitioner,*

vs.

THOMAS W. NICHOLSON, *Respondent.*

BRIEF OF RESPONDENT OPPOSING PETITION FOR WRIT OF CERTIORARI

ROBERT W. BEACH
Attorney for Respondent.

3107 Eastlake Avenue East,
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PERTINENT STATUTES

The statement of petitioner under the heading "Statutory Provisions" on pages 3 and 4 of the Petition for a Writ of Certiorari has omitted one very important statute which should be considered by this Honorable Court if the petition for certiorari should be granted, namely,

> 35 U.S.C., Sec. 103. **Conditions for patentability: non-obvious subject matter.** A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

MODIFIED STATEMENT OF THE CASE

The "Statement of the Case" by petitioner includes on page 5 of the petition the statement,

> "Nicholson thereupon appealed to the United States Court of Appeals for the Fourth Circuit, which after argument held that the District Court was correct in every respect except in its holding that claim 8 of the Mullis patent was valid."

The United States District Court Judge had held that the Nicholson Accumat machine infringed claim 8 of the Mullis patent here in question and the Court of Appeals for the Fourth Circuit *did not reach this question.* Instead, the Appellate Court held claim 8 of the Mullis patent to be invalid *without any comment* upon the question as to whether if that claim had been valid it would have been infringed by the Nicholson Accumat barker.

Also, the Fourth Circuit Court of Appeals ruled upon only one of the grounds asserted by Nicholson as a basis for invalidity of the Mullis patent here in issue. Various other grounds establishing invalidity of the Mullis patent were also urged, but the Appellate Court found it unnecessary to rely on them in order to adjudicate the Mullis patent here in issue to be invalid.

If this Honorable Court should grant the petition for certiorari, and if thereafter this Honorable Court should reverse the ruling made by the Fourth Circuit Court of Appeals as to the invalidity of claim 8 of the Mullis patent, it would be necessary to remand the case to such Appellate Court for consideration of the other grounds on which it was further asserted claim 8 of the Mullis patent was invalid, and also, perhaps, for consideration of the question as to whether the Nicholson Accumat barker constituted an infringement of claim 8 of the Mullis patent. Consideration of these questions was, of course, rendered unnecessary by the decision reached by the Appellate Court.

At the bottom of page 5 the petition states that Brundell patent 2,786,499 was,

> "cited *and relied upon* by the Examiner in the Patent Office during the prosecution of the application resulting in the Mullis patent." (Italics supplied)

It is respectfully submitted that said Brundell patent was not "relied upon" by the Examiner in the Patent Office with respect to claim 8 of the Mullis patent here in issue because, if the Examiner had properly "*relied upon*" that patent, he would have refused the allowance of that claim and it would *not* have appeared in the Mullis patent as issued. What consideration the Patent Office Examiner gave the Brundell patent in relation to claim 8 of the Mullis patent, if any, does not appear, but in view of the logical and sound analysis of the Brundell patent and its application to claim 8 of the Mullis patent given by the Appellate Court in holding such claim invalid, it appears evident that the Patent Office Examiner gave little or no consideration to the Brundell patent with respect to that patent claim.

At the bottom of page 6 of the petition reference is made to the Mullis patent rotating tank 104 filled with air under pressure. Claim 8 of the Mullis patent recites "an annular tank containing a fluid under pressure." The Nicholson Accumat barker did not have such a tank. The claim also specifies

> "fluid pressure operated means mounted on the inner peripheral wall of said tank in communication with the interior of said tank."

The Nicholson Accumat barker did not employ such fluid pressure operated means.

At the middle of page 7 the petition states with respect to gas pressure devices for moving barking arms, that

> "the *usual* construction had been one in which the gas

was supplied from a stationary source." (Italics supplied)

This statement is equivocal because prior art patents in the record of this case disclose constructions in which gas under pressure is carried by a rotary ring for the purpose of actuating log barking arms. A statement as to what the alleged "usual" construction was is therefore misleading.

The same comment applies to the statement at the bottom of page 7 of the petition with respect to what was "usual in prior constructions" for supplying gas under pressure to the ring. Prior art patents in the record disclose entirely comparable arrangements for supplying such gas under pressure to the ring.

In discussing the Brundeli patent at the middle of page 8 the petitioner asserts that the

"cylinder 140 contains a liquid, such as oil:"

Actually the specification of the Brundeli patent at column 3, line 44, states

> "In order to introduce *fluid* into the cylinder 140 in front of piston 142 a flexible conduit 158 communicates with an inlet 156 in the cylinder. The flexible conduit in turn is connected to a circular conduit 160 carried by the rotor and in turn in *fluid* communication with other cylinders like 140 that are associated with the other tool arms, not shown. A pressure gauge 166 is in communication with the circular conduit 160 and to introduce *fluid* into the circuit a conduit 164 communicates with the circular conduit 160." (Italics supplied)

While it is true that liquid is mentioned as an example in other portions of the description, the generic term "fluid" to include gas under pressure is recited in the portion of the specification quoted. Consequently it is entirely reasonable that the cylinder 140 may contain gas under pressure

instead of liquid under pressure. It is therefore clear that petitioner asserts an unduly restricted interpretation on the Brundell patent.

At the bottom of page 8 the petition states that,

> "The oil in the cylinders 140 is incompressible, and serves merely as a mechanical connection between the various rubber bands,"

but, as pointed out above, the teaching of the Brundell patent is not *restricted* to oil but the language used in the description of the Brundell mechanism is sufficiently broad to encompass the use of *either* compressed gas or liquid under pressure in the generic term "fluid" used in the portion of the description quoted above from the Brundell patent.

Moreover, appellant's Statement of the Case omits mention of any prior art patents other than Brundell patent 2,786,499. Actually the decision by the Fourth Circuit Court of Appeals refers also to Emery patent 2,477,922, Whitlock patent 2,591,751 and Nicholson patent 2,802,495, although not discussing them in detail, and these patents should be given consideration by this Honorable Court if the petition for certiorari is granted.

QUESTION PRESENTED IS IMPROPER BASIS FOR GRANTING CERTIORARI

The statement of the question presented for review on page 2 of the petition is the usual one in nearly any patent infringement suit as to whether a particular patent claim is invalid over certain specific prior art. There is nothing unusual in this analysis and comparison.

It is not even contended by petitioner that any special reason, such as enumerated in Rule 19 of this Honorable Court, is here involved.

There is here no conflict of decisions by different courts of appeal.

There is here no question of Federal law, important or otherwise, not previously settled by this Honorable Court.

There is here no Federal question decided in conflict with applicable decisions of this Honorable Court.

The Fourth Circuit Court of Appeals did not depart from the accepted and usual course of judicial proceedings.

On the contrary, the District Court in this case fell into error, as admitted by the petitioner in his brief, with respect to the subject matter here in point, and the Appellate Court simply corrected that error and reversed the District Court, as it was the place and duty of the Appellate Court to do.

Looking at the alleged question presented for review on pages 2 and 3 of the petition somewhat more closely, petitioner points out that the District Court found the claim to be valid. Such finding was based on an erroneous interpretation of prior art and in correcting that interpretation it was, of course, entirely logical, proper and necessary for the Appellate Court to reverse the holding of the District Court as to the validity of the claim.

As a second point relating to the question for review petitioner states that the patent relied upon by the Court of Appeals was one considered by the Examiner in the United States Patent Office. The Court of Appeals did not rely entirely on a single patent in its holding of invalidity. Moreover, there is nothing in the record to indicate what "consideration" was given to this patent by the Patent Office Examiner with respect to the claim of the patent here in question.

As to the third point on page 3 of the petition relating

to the question, Nicholson did not; and did not purport to, present a *patent* expert witness and there was no examination of that witness with respect to claim 8 of the Mullis patent here in issue. Such examination of a *layman* with respect to a *patent claim* would, of course, have been improper. Moreover, whether a particular individual had ever seen a machine of the patented type is not probative as to validity of a patent on such machine. Whether or not a patented machine has ever been constructed is completely immaterial as to the validity of a patent on that machine. There is no requirement in the law that a machine be constructed prior to a patent being granted on it.

Relative to item 4 it is entirely immaterial whether the construction and operation of the patented machine was or was not explained to the District Court in oral testimony. A patent is a document which speaks for itself and the statute 35 U.S.C. Sec. 112 requires that,

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

If the description of a patent is properly presented the operation and construction of the machine disclosed can be understood by the court *from the patent itself*, except in unusual cases, and there is no intention by the petitioner that this is such a case. If the description in the patent is *not* sufficiently complete to enable the court to understand its construction and operation in the usual case, the patent is invalid for the further reason that it does not comply with the statute quoted above.

In item 5 relative to the question presented for review, appearing on page 3 of the petition, petitioner complains that,

> "No evidence was introduced by the party attacking the validity of the patent as to the equivalency of the structure shown in the prior patent to that covered by the claim held invalid by the Court of Appeals."

Presumably the petitioner has reference to oral testimony. It is, however, the *disclosure of the prior art* in documentary form which constitutes the statutory bar to a patent, and such prior art documents are entirely competent to speak for themselves without the necessity of any interpretative oral testimony. This was the basis of the error into which the District Court fell, namely, improperly interpreting the prior art Brundell patent, 2,786,499, as admitted by petitioner in its petition, and it was this misinterpretation of that prior art patent which the Court of Appeals corrected in reversing the District Court. No oral testimony was necessary to reach the proper interpretation of the prior art patent and the conclusion of invalidity which necessarily followed.

Item 6 on page 3 of the petition, as to the question presented for review that the District Court actually saw the patented machine, is completely immaterial. There is no indication or contention in the petition that the Appellate Court did not understand the machine shown in the Mullis patent, or that observation of the machine was necessary to an understanding of it. Actually, the Mullis patent contains detailed drawings, as well as a description of the subject machine, which are quite understandable. Moreover, as has been mentioned above, whether a machine made the subject of a patent was or was not ever constructed is immaterial as far as the validity of the patent is concerned.

In summary, therefore, it is evident that the petition here is simply requesting that this Honorable Court give consideration to whether a claim on a particular patented machine is or is not valid over particular prior art. No new or unusual question of law is involved. A ruling on the question presented by the petition would not provide any appreciable guidance to lower courts in future patent cases which would warrant consideration of this case by this Honorable Court.

THE ALLEGED GROUNDS ARE AN INSUFFICIENT BASIS FOR GRANTING OF THE WRIT OF CERTIORARI

The only ground asserted by the petition as a basis for urging this Honorable Court to grant the writ is at page 9, that,

> "this case constitutes the decision of a Federal question in a way in conflict with applicable decisions of this Court, and also so far departs from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision."

Under this heading the petition makes reference to several Supreme Court cases without clearly pointing out where the decision of the Court of Appeals in the present case is in conflict with any of such prior decisions. In this connection it will be helpful to consider separately the several cases cited.

Graver Tank Co. v. Linde Air Products, 336 U.S. 271

At pages 10 and 11 of the petition the *Graver Tank* case is discussed with respect to the point that,

> "the District Court's findings and conclusions are not to be set aside unless clearly erroneous."

The converse of this statement is, of course, equally true that,

> It is the *duty* of the Appellate Court to *set aside* the findings and conclusions of the district court where they are "clearly erroneous,"

as petitioner admits that they were in the present case on page 11;

> "It is true that the District Court made an error in failing to appreciate that the Brundell patent showed in Fig. 1b an arrangement in which the pressure on the arms was equalized by an interconnection between them."

The District Court simply failed to interpret the disclosure of the Brundell patent correctly, as is recognized by the petitioner itself. Such corrected interpretation was, of course, necessarily contrary to the findings of fact made by the District Court on this point and the conclusions drawn from such erroneous findings, which resulted in reversal of the District Court's conclusion as to the validity of claim 8 of the Mullis patent. Certainly the Court of Appeals for the Fourth Circuit can not be criticized for doing its appellate duty in this way.

Even if the District Court had not made findings of fact admitted by petitioner here to state an erroneous interpretation of the Brundell patent the *Graver Tank* case is not to be interpreted as forbidding an Appellate Court to consider interpretations made by a lower court and reverse them or revise them in appropriate cases. This aspect of the *Graver Tank* case has been considered by this Honorable Court in the later case of *The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corporation*, 340 U.S. 147. In that case both the District Court and the Court of Appeals actually had concurred in their opinions as to the findings of fact, but the Supreme Court *reversed both lower courts*, stating

> "It is urged, however, that concurrence of two courts

below, in holding the patent claims valid, concludes this Court. A recent restatement of the 'two-court rule' reads, 'A court of law such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing or error.' *Graver Tank Co. v. Linde Co.*, 336 U.S. 271, 275, 621 O.G. 5. The questions of general importance considered here are not contingent upon resolving conflicting testimony, for the facts are little in dispute. We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter, which cannot stand as a matter of law."

So, in the instant case the District Court made here no finding of fact on the question of *invention* which the Appellate Court set aside.

It cannot properly be contended by petitioner, therefore, that the decision of the Fourth Circuit Court of Appeals here is in any way in conflict with the case of *Graver Tank Co. v. Linde Air Products*, 336 U.S. 721, as that case was interpreted by the later case of *The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corporation*, 340 U.S. 147, with respect to the point raised by the petitioner.

***Commissioner v. Duberstein*, 366 U.S. 278**

The quotation given by petitioner from this decision on page 11 relates to

"factual inferences from undisputed basic facts."

The basic fact here involved, which is undisputed, is that certain prior art patents existed. The District Court then drew "factual inferences" from such prior art. On that basis, as petitioner states on page 11,

"the District Court drew the conclusion from the facts that the Mullis patent was valid."

Such "factual inferences" were, however, actually not "facts," but the inferences drawn by the District Court were erroneous as admitted by petitioner on page 11, as quoted above. Consequently, "the rule" in the case of *Commissioner v. Duberstein* does *not* apply in the present case because of such erroneous factual inferences drawn by the District Court.

The petitioner has failed to point out how the decision of the Appellate Court here was in conflict with the decision of *Commissioner v. Duberstein*.

Preceding the dicussion of the *Gracer Tank* case and the *Duberstein* case, petitioner, on pages 9 and 10, makes reference to the point that,

1. The court actually saw the Mullis machine after the trial;
2. The witness Holekamp saw a Brundell patent ma-machine;

and consequently concluded that the District Court did *not* base his decision "purely on documentary evidence." It cannot be disputed, however, and, in fact, is admitted by the petitioner, that the interpretation of the Brundell patent by the District Court was in error. There is no explanation by the petitioner how the fact that the District Court saw the Mullis machine has any bearing on his misinterpretation of the Brundell patent. Also, while Holekamp may have seen a machine such as disclosed in the Brundell patent, there was no testimony regarding the feature of this machine which was misinterpreted by the District Court. What the reason for the District Court's misinterpretation may have been is immaterial and of no interest to this Honorable Court, nor to any other District Court or Appellate Court which may be deciding a patent case.

In one breath the petitioner contends that there *was* evidence regarding the prior art which would foreclose the Court of Appeals from considering the facts found by the lower court, and in the next breath, at the bottom of page 12, petitioner states

> "No evidence was offered by him as to the applicability of the references to the claim."

Consequently, the interpretation of the prior art was up to the lower court in the first instance and up to the Appellate Court in the later instance, as that court commented with respect to the basis for the decision by the lower court:

> "His conclusion was not evolved from conflicting testimony but rather upon a comparative reading of the patents. Inasmuch as these documents are equally as available to us, the resolution of the question of patent-validity by the trial court is not as binding here as would be a factual ascertainment upon varying evidence * * *. Our examination convinces us that Brundell's patent, No. 2,786,499, filed March 22, 1954, issued March 26, 1957 clearly anticipated Mullis."

Thus, it is evident that the basis for the Appellate Court's decision was documentary interpretation involving no question of law constituting a proper basis for the granting of petitioner's request for a writ of certiorari.

***Coupe v. Royer*, 155 U.S. 565, 577**

This case is cited at page 14 of the petition for the proposition that,

> "Patent claims should be construed to validate them if possible."

It is not clear to what portion of this long decision petitioner has reference with respect to this statement, but certainly it has not shown in this regard that the decision

of the Appellate Court *as to the validity of the Mullis patent* is in conflict with the *Coupe v. Royer* case.

Actually, if a review of the matter of *infringement* of the Mullis patent by the Nicholson Accumat barker were here under consideration petitioner would be correct that the decision of the District Court was in conflict *on this point* with the decision of the Supreme Court in *Coupe v. Royer*.

In finding infringement of claim 8 of the Mullis patent by the Nicholson Accumat machine, which point was not considered in the decision of the Court of Appeals, the District Court simply ignored limitations in the Mullis patent claim. This is contrary to the pronouncement of this Honorable Court in the case of *Coupe v. Royer* at the middle of page 576, as follows:

> "The principle of construction which we think applicable to the plaintiff's patent is that such construction must be in conformity with the *self-imposed limitations which are contained in the claims*. Such claims are the measure of their right to relief. * * * the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office. * * * The courts should be careful not to enlarge by construction the claims which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms." (Italics supplied)

In the present case the District Court simply disregarded limitations in claim 8 of the Mullis patent in finding infringement, yet these are the very limitations which petitioner here contends should be given effect *and even interpreted in a more restricted fashion* by "recourse to the specification and drawings" (Petition, p. 14) in order to urge this Court to reverse the decision of the Fourth Circuit Court of Appeals that the Mullis claim is invalid. Perhaps the petitioner feels that this is a safe position to take

in connection with this petition because it is not here asking that the question of infringement, as distinguished from validity, be reviewed by this Honorable Court.

In this connection, as stated at the top of page 14 of the petition, claim 8 of the Mullis patent uses the term "a fluid under pressure" and the Brundell patent at column 3, lines 44 and 48, as quoted above at page 4, also uses the term "fluid." In order to urge the validity of claim 8 the petitioner then contends that the word "fluid" in the Mullis claim

"should be construed to mean a gas" (Petition, p. 14) while the term "fluid" as used by Brundell should be interpreted as a *liquid. But the fluid in the pipe interconnecting the barker arm actuators in the Nicholson Accumat barker also is a liquid, like Brundell,* and *not* a *gas* as disclosed by Mullis.

It is believed, therefore, that petitioner would have great difficulty showing that the decision of the Fourth Circuit Court of Appeals was inconsistent with the decision of *Coupe v. Royer.*

***Hildreth v. Mastoras*, 257 U.S. 27**

This case is cited by petitioner as supporting his position that the presumption of validity of the Mullis patent is

> "strengthened where, as here, the prior art has been considered by the Patent Office as is shown by the list of references on the back of the Mullis patent."

The petition then states,

> "This rule has been recognized by this Court, in *Hildreth v. Mastoras*, 257 U.S. 27."

Actually, this position of the petitioner represents a misinterpretation both of the facts of the present case and of the holding of this Honorable Court in the *Hildreth* case.

In the *Hildreth* case the patent in question had been involved in an interference proceeding with *five other copending patent applications* in the Patent Office. As this Honorable Court commented in that case,

> "The controversy in the Patent Office lasted five years, was strenuously contested, and was carried to the Court of Appeals of the District of Columbia."

On page 32 appears the further comment,

> "This, as already said, is the claim which was framed in the Patent Office as the issue of the interference proceeding, and of which Dickinson was given priority over all. The presumption of priority and novelty which arises from the granting of a patent must have greatly increased weight when the claim of the inventor is subjected to such close and careful scrutiny under the stimulus of a heated contest."

In the present case the Mullis patent *was not involved in any interference*. Moreover, there was *no evidence* that *any* of the prior art cited by the Patent Office was considered at all *with respect to claim 8* of the Mullis patent, which is here in issue.

On what basis then can the petitioner legitimately contend, as stated on page 9 of its petition, that the case of *Hildreth v. Mastoras* is a decision of this Court in conflict with the decision of the Court of Appeals in this case?

CONCLUSION

The only ground which the petitioner further urges for granting of this petition by this Honorable Court is the statement at page 9 of the petition that,

> "The Decision of the Court of Appeals in this case * * * so far departs from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision."

It is respectfully submitted that the foregoing discussion has amply established that the consideration given to this case by the Court of Appeals was simply that which would normally be expected of a reviewing court in a patent case where invalidity of a particular patent had been alleged on the basis of prior art. Certainly this procedure follows

"the accepted and usual course of judicial proceedings." Only if the Appellate Court had followed *any other* course could it properly have been contended that such court had departed from the "accepted and usual course" of appellate review proceedings.

Under all the circumstances, therefore, it is respectfully submitted that the petitioner has presented no valid ground for its petition for a writ of certiorari being granted, and such petition should therefore be denied.

Respectfully submitted,

ROBERT W. BEACH
Attorney for Respondent.

CERTIFICATE OF SERVICE

It is hereby certified that three true copies of this Brief have been served on Jennings Bailey, Jr., by air mail, with postage prepaid, addressed to 1317 F Street Northwest, Washington 4, D.C., this 15th day of August, 1963.

ROBERT W. BEACH
Attorney for Respondent.